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CENTRAL FAX CENTERIN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAY 18 2009

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| Applicant(s): | Patrick C. St. Germain |) | |
| Application No. | 10/682,444 |) | |
| Filed: | October 9, 2003 |) | Group Art Unit: 3721 |
| For: | APPARATUS FOR MAKING INTERFOLDED PRODUCT |) | |
| Examiner: | Sameh H. Tawfik |) | Attorney Docket No. <u>SSS-106</u> |

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's withdrawal of the outstanding 35 U.S.C. 102(b) rejections is noted with appreciation. The remaining 35 U.S.C. 103(a) rejections should be reversed.

Regarding claims 11 and 13-16, the Stemmler reference shows an interfolder, but as conceded by the Examiner, does not show web dispensers upstream of the interfolder that form at least one longitudinally extending fold line and produce at least one fold in the web that is fed to the folding rolls of the interfolder (Examiner's Answer, p. 3). The Examiner also concedes that Stemmler does not show folding boards as web dispensers (Examiner's Answer, p. 4).

No valid rationale has been advanced as to why one of ordinary skill would have turned to the Hermach reference directed to newspaper presses. The Hermach apparatus is not an interfolder, but is a structurally different apparatus that serves an entirely different purpose – the folding of bulky newspaper editions. That expedient has nothing to do with paper converting machinery developed for interfolding paper tissue webs and the like for ultimately producing packages of tissue. Hermach's apparatus solves an entirely different problem. One of ordinary skill would not have had any reason to interfold a newspaper,

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thereby making it more difficult to open up the newspaper for reading. The record is devoid of any motivation for one of ordinary skill in the newspaper folding arts to do so.

Likewise, the record is devoid of any motivation for one of ordinary skill in the paper converting art to turn to the newspaper folding art when seeking to improve the packaging of tissue. The Examiner has failed to provide any rationale why one of ordinary skill would have done so. The Examiner's unfounded and unsupported assertion that Hermach discloses "a similar apparatus" is vague and erroneous, and fails to provide the required motivation.

The teachings of Stemmler and those of Hermach are not combinable. Besides, neither Stemmler nor Hermach had the same objective or "goal" as the present invention – compact packaging of interfolded web segments. One of ordinary skill would not have combined the teachings of Stemmler and Hermach at the time the claimed invention was made.

The U.S. Supreme Court in KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007), noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; instead, it must be shown explicitly that those of ordinary skill in the art would have had some apparent reason to combine the known elements in the fashion claimed. KSR, 127 S.Ct. at 1741, 82 U.S.P.Q. at 1396. No such reason is of record in this case. The articulated reasoning in support of an obviousness rejection required under KSR is lacking in this case. There is no persuasive explanation as to why a person of ordinary skill in the paper converting art would have had a reason to modify the interfolder taught by Stemmler. There is no credible evidence of record that the structural design of an interfolder equipped with pre-folding devices as defined by the present claims was a routine modification.

In KSR, the Supreme Court cautioned, however, against falling prey to hindsight bias and that a fact finder should be aware of the distortion caused by hindsight reasoning and arguments reliant on *ex post* reasoning. KSR; 127 S.Ct. at 1742, 82 U.S.P.Q.2d at 1397. Here the record as well as the Examiner's Answer lead to the inescapable conclusion that *ex post* reasoning has played a major role in the selection of the applied references impermissibly using appellant's own teachings as a guide.

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The Examiner's interpretation of the independent claims is erroneous as well. The holding in In re American Academy of Science Tech Center, 70 U.S.P.Q. 1827, 1834 (Fed. Cir. 2004), has been misconstrued. The claims may not be construed so as to ignore the terms thereof, or so as to extend beyond that what the specification fairly teaches. In American Academy, the Court did not do so. Instead, the holding in American Academy clearly is that limitations may not be read into a claim from a preferred embodiment. That is not the case here. The claims here are limited to interfolders provided with upstream pre-folding devices that put a longitudinal fold in the web before the web is fed to the folding rollers, yet in maintaining the rejections the Examiner has elected to ignore completely the art recognized meaning of the term "interfolder" and its operation.

As to the purported need to "reduce the width of the sheets" (Examiner's Answer, page 6), Stemmler does not mention or recognize any such need. Neither does Hermach.

Stemmler seeks to provide a solution for problems encountered when seeking to produce numerically correct partial stacks from interfolded sheets (col. 1, lines 8-12). Hermach, on the other hand, seeks to provide a more efficient way to fold and collate bulky newspaper editions (col. 1, lines 29-48). Neither objective provides a justification or motivation for one of ordinary skill to combine selected features of both.

Regarding the outstanding rejection of claim 12, the Examiner concedes that neither Stemmler nor Hermach show the claimed double "c" fold (Examiner's Answer, p. 4). Of course, a double "c" fold would be unworkable in any newspaper edition in any event.

A double "c" fold is shown in appellant's FIGURE 3(a) at 118. Notwithstanding the Examiner's assertions to the contrary, no such fold can be found in FIG. 3 of DuFresne. Merely saying so does not make it so.

Regarding the additional Graham v. John Deere Co., 383 U.S. 1 (1966), requirements mandated by KSR that must be considered when evaluating *prima facie* obviousness, the level of ordinary skill in the paper converting art remains unresolved. The Examiner's Answer is silent on this point. Likewise, the objective evidence of unobviousness, the nomination for the IDEA Achievement Award (Evidence Appendix, Tab 1), remains un rebutted.

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Conclusion


The outstanding rejections based on 35 U.S.C. 103(a) are not supported by a preponderance of the evidence in the record.

The attempted combination of selected reference teachings derived from diverse fields of art with impermissible reliance on hindsight cannot be justified. No valid rationale has been advanced why one of ordinary skill in the paper converting art would have done what the Examiner now seeks to do. Rejections on obviousness grounds cannot be sustained by mere conclusory statements. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006).

The obviousness rejections of all claims on appeal should be reversed.

Respectfully submitted,

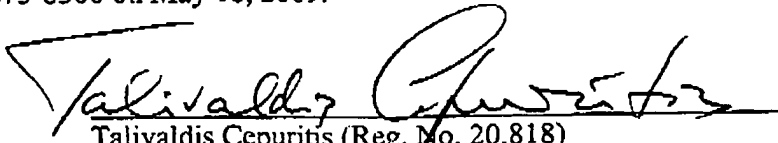
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I hereby certify that this REPLY BRIEF is being transmitted by facsimile transmission to Fax No. 571-273-8300 on May 18, 2009.


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